

Appl. No. 10/647,112  
Amdt. dated February 3, 2006  
Reply to Office Action of November 3, 2005

## **REMARKS**

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

Claims 1-15 were pending in this application. Claims 2-14 have been amended herein. Claim 1 has been canceled without prejudice. Claim 16 has been added. Thus, claims 2-16 are pending. Support for the amendments and new claim can be found in the specification and claims as originally filed. The present amendments and new claim introduce no new matter, and thus, their entry is respectfully requested.

### **Information Disclosure Statement**

The information disclosure statement filed on December 9, 2003 was objected to for failing to comply with 37 C.F.R. 1.98(a)(2). A supplemental information disclosure statement was filed on January 23, 2006 containing the cited foreign patent document, thereby rendering this objection moot.

### **Specification**

The abstract was objected to because it was not in single paragraph form according to MPEP 608.01(b). The abstract was amended to become one paragraph, and applicant believes this amendment overcomes the Examiner's objections, and thus, withdrawal of the objection is

Appl. No. 10/647,112  
Amdt. dated February 3, 2006  
Reply to Office Action of November 3, 2005

requested.

The specification was objected to for failing to provide a proper antecedent basis for “a thick film holographic element” of claim 10 and “a surface hologram” of claim 11 as per 37 C.F.R. 1.75(d)(1). Applicant has amended claim 10 to read “a holographic element”, a term which is described on pages 2 and 3 of the specification. Applicant has also amended claim 11 to read “a synthetic surface hologram”, a term which is described at the bottom of page 5 of the specification. Applicant believes these amendment overcome the Examiner’s objections, and thus, withdrawal of the objections is requested.

#### **Claim Rejections - 35 U.S.C. 112, second paragraph**

The Examiner rejected claim 1 as being indefinite under 35 U.S.C. §112, second paragraph. Specifically, the Examiner states that the phrase: “for example” renders the claim indefinite because it is not clear whether the elements following this phrase are part of the claimed invention. Applicant has cancelled claim 1 without prejudice, thereby rendering this objection moot.

#### **Claim Rejections - 35 U.S.C. 102**

Claims 1-12 stand rejected under 35 U.S.C. 102(e) as being anticipated by Shires (5,111,313).

Appl. No. 10/647,112  
Amdt. dated February 3, 2006  
Reply to Office Action of November 3, 2005

Without conceding the correctness of the Examiner's position, but to expedite allowance of the subject application, Applicant has cancelled claim 1 without prejudice. Applicant has added new independent claim 16. Applicant respectfully submits that Shires does not teach all of the limitations of claim 16 principally because it does not teach at least a DOE adapted to separate a spectrum of light. Instead, the light originates as specific colors (via the laser amplifier and diodes) that are later reconstructed to create the image. See cols. 3-4, lines 30-42; cols. 7-8, lines 67-30. Therefore, the Shires DOE does not perform a light separation function to create an image on a predetermined area, but rather, Shires performs a light combination function. Accordingly, Shires does not anticipate the claims presented and withdrawal of the above rejection is requested.

Dependent claims 2-12 are further believed to be allowable as being dependent from allowable independent claim 16, and Applicant requests that the rejections of these claims be withdrawn.

#### **Claim Rejections 35 U.S.C. 103**

Claims 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shires in view of Parker et al. (2004/0066547). Claims 13-15 are dependent on allowable independent claim 16 which is distinguishable over Shires for reasons stated above. Parker does not overcome the deficiencies of Shires. Parker describes a HOE designed to combine the presented image with a background image, but does not perform a separation function. See, e.g., ¶¶ 33 and

Appl. No. 10/647,112  
Amdt. dated February 3, 2006  
Reply to Office Action of November 3, 2005

35.

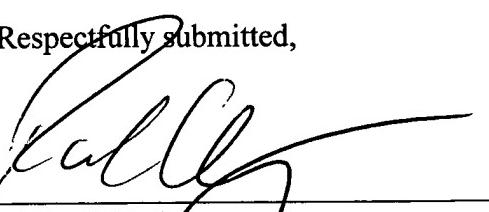
Applicants further submit that all dependent claims incorporate the limitations of the independent claims upon which they depend. As Applicants assert that the independent claims of the present application are allowable, Applicants submit that these claims are also allowable and request that the rejections of these claims be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the requested application is now in condition for allowance and a notice to that effect is earnestly requested.

Authorization is hereby given to charge any additional fee, or credit any overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

By

  
Richard Wydeven  
Attorney for Applicants  
Registration No. 39,881  
ROTHWELL, FIGG, ERNST & MANBECK, p.c.  
Suite 800, 1425 K Street, N.W.  
Washington, D.C. 20005  
Telephone: (202)783-6040

2800-117 Response to Office Action